



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,125	06/26/2003	Melvin S. Mogil	024643-00015	3648

4372 7590 11/03/2008
ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

MORGAN JR, JACK HOSMER

ART UNIT	PAPER NUMBER
----------	--------------

3782

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

11/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/606,125</p>	<p>Applicant(s) MOGIL, MELVIN S.</p>	
	<p>Examiner JACK H. MORGAN JR</p>	<p>Art Unit 3782</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Nathan J. Newhouse/
Supervisory Patent Examiner, Art Unit 3782

Jack H Morgan
Examiner
Art Unit: 3782

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments regarding the previous rejections made are not persuasive. Applicant argues that Mogil '677 teaches away from the present invention, as Mogil is a collapsible container. Examiner does not find this persuasive, as the rigid liner will do more to protect items held in the collapsible container of Mogil, but (as noted previously) the possibility to remove the rigid liner will allow full collapsing of the container for storage purposes. Applicant argues that one of ordinary skill in the art would not understand to take out the rigid liner from the collapsible container in order to store the container. Examiner finds this unpersuasive, as taking out what is inside a container to store it is well known in the container/storage art.

With respect to applicant's arguments regarding commercial context, examiner is not persuaded by the statements referring to the "rather modest claims". Examiner understands that the claims are commensurate with the invention, and acknowledges that they may correspond to the commercial products of the inventors. However, this alone does not entitle the inventors to a patent. Only claimed subject matter which is novel and non-obvious will result in a patent. As such, applicant's arguments are unpersuasive.

With respect to the Preston '338 rejection, examiner notes that reasoning is present in the final rejection, specifically that the partitions of Preston are present to keep separate different items stored in the cooler, and that is the benefit provided to the container of Mogil.

With respect to applicant's arguments regarding the previous response to arguments, examiner notes that, as stated previously, collapsibility is still possible in the modified Mogil container with the removal at user's pleasure of the rigid liner. As such, due to the removable nature of the liner, the collapsible nature of Mogil is not destroyed as alleged by applicant.

With respect to the foldable liner of Mogil, examiner notes that the rigid liner of Preston would replace said foldable liner where it was present. Examiner notes that the foldable liner is not required, and any use it has (in preventing spills) is accomplished by the replacement rigid liner.

With respect to the Beales reference, examiner maintains his belief that one of ordinary skill in the art would understand that the locking mechanism of Beales is not permanent, as no glue or adhesive is applied with respect to that final locking in place step. As such, applicant's argument is not persuasive. Motivation to add the liner of Beales to the container of Mogil is present in the ability to partition the container into smaller sub-sections, as shown by Beales.